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09/760,096	01/10/2001	Janet L. Benton	OIC0290US	1687
60975 7590 06/10/2008 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER SHRESTHA, BIJENDRA K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/760,096

**Applicant(s)**

BENTON ET AL.

**Examiner**

BIJENDRA K. SHRESTHA

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 5) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Independent claim 1 recites "a system comprising an end-user module to display..., determine...; and inter-provider module ... operable to receive..., determine....."; independent claim 8 recites "software for ...executed by computer to display..., determine..."; and independent claim 22 recites "a system ..comprising means for displaying..., means for determining..., means for prompting..., means for providing ...". These claims are non-statutory because it is directed towards software, per se, lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.

2. Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claims 15-21, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a

different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being unpatentable over

Gilles et al., U.S. Patent No. 7,333,600 (reference A is attached PTO-892) in view of

Wong et al., U.S. patent No. 5,890,175 (reference B in attached PTO-892).

5. As per claim 1, 8, 15 and 22, Gilles et al. teach system and method where

one or more service items correspond to a corresponding local product item of one or more local product items available from an inter-provider ordering module (see Fig. 1, column 3, lines 42-58; where telecommunication service items includes caller ID (58), remote access call forwarding (56), call waiting (62), each local product item

corresponds to a local item type (see Fig. 1; column 3, lines 31-37; where each LEC manages one or more Central Office (CO) serving particular geographic region to provide local item type to end-user) ,

each of the one or more local item types has a corresponding set of local specifications that describe the local item type (see Fig. 5; where Residential customer have local item type "Caller ID (58) while business customer have "Call FWD (60) and Call Wait (62)";

determine one or more developer defined labels (DDLs) for each of the one or more service items that have a corresponding local product item, wherein each DDL comprises a local specification from the set of local specifications that is missing from the set of service specifications (see Fig. 5; column 9, lines 20-61; where each Central Office (location) contain feature file (DDL))

determine whether an end-user requested service item relates to a service item type having at least one associated (DDL); if the requested service item relates to a service item type having at least one DDL, prompt the end-user for a value of each additional DDL-specified attribute in connection with creation of an end-user order for the requested service item (see Fig. 6; column 9, lines 62-67); and

communicate the end-user order for use in subsequently creating a corresponding inter-provider order; and the inter-provider ordering module coupled to the end-user ordering module and operable to: receive the end-user order; determine whether the end-user order has a value for each additional DDL-specified attribute ; and if the end-user order has a value for the additional DDL-specified attribute, automatically

map the value from the end-user order to an appropriate field of the inter-provider order (see Fig. 6, column 10, lines 46-56).

Gilles et al. do not teach displaying a service provider product catalog to an end user, wherein the service provider product catalog comprises one or more service items, each corresponding to a service item type, each service item type has a corresponding set of service specifications that describe the service item type.

Wong et al. teach displaying a service provider product catalog to an end user, wherein the service provider product catalog comprises one or more service items, each corresponding to a service item type, each service item type has a corresponding set of service specifications that describe the service item type (Wong et al., Fig. 1; column 1, lines 57-60)

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate displaying a service provider product catalog to an end user, wherein the service provider product catalog comprises one or more service items, each corresponding to a service item type, each service item type has a corresponding set of service specifications that describe the service item type of Gilles et al. because Wong et al. teach including above features would enable to provide logical catalog structure that mimics traditional store architecture making it easy for customers to browse through the catalog without training or disorientation (Wong et al., column 2, lines 40-43).

6. As per claims 2, 9 and 16, Gilles et al. in view of Wong et al. teach the inter-provider order comprises an industry standard Local Service Request (see Fig. 1, LEC (22); column 3, lines 27-33).

7. As per claims 3, 10 and 17, Gilles et al. in view of Wong et al. teach the requested service item is an unbundled port (see column 2, lines 15-20);

the additional DDL-specified attribute is selected from the group consisting of a Local Existing Account Number (LEAN) and a Local Existing Account Telephone Number (LEATN) (see Fig. 1; abstract; where connection to specific wholesaler or Central Office (CO) depends upon customer telephone number and corresponding switch connected for the service);

the associated service item type is provided for mapping an unbundled port from an end-user order to an LSR (see column 2, lines 15-20).

8. As per claim 4, 11 and 18, Gilles et al. in view of Wong et al. teach the DDL allows a developer of the end-user ordering module to provide for collection of additional attribute values in response to an industry mandated change in LSR format without necessitating the development of new software (see Fig. 2; column 7, lines 15-27; where customer request in EDI format is reformatted into reseller forms and format without human intervention).

9. As per claims 5, 12 and 19, Gilles et al. in view of Wong et al. teach the value is automatically mapped to appropriate fields of multiple forms included within the LSR (see Fig. 1; Fig. 6; column 9, lines 62-67).

10. As per claims 6, 13 and 20, Gilles et al. in view of Wong et al. teach the end-user ordering module is operable to relate the requested service item to a product specification and relate the product specification to a service item type to determine whether the requested service item relates to a service item type having a DDL (see Fig. 6; column 10, lines 46-57).

11. As per claims 7, 14 and 21, Gilles et al. in view of Wong et al. teach the end-user ordering module is further operable to validate that the value for the additional DDL-specified attribute has been supplied before communicating the end-user order (see Fig. 2; Validate (124); column 7, lines 10-14).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Abjanic et al.(U.S. Pub No. 2004/0205597) teaches network apparatus for switching based on content of application data.

Allard et al. (U.S. Patent No. 6,249,773) teach electronic commerce with shopping list builder.

Foesaneanu et al. (U.S. Patent No. 5,610,910) teach access to telecommunications networks in multi-service environment.

Levine et al. (U.S. Patent No. 5,745,681) teach stateless shopping cart for the web.



Postelnik et al. (U.S. Patent No. 7,069,235) teach system and method for multi-source transaction processing.

Salvo et al. (U.S. Patent No. 6,341,271) teach inventory management system and method.

Sylvain (U.S. Patent No. 6,118,777) teaches system and method for providing competing local exchange carriers unbundled access to subscriber access lines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)270-1374. The examiner can normally be reached on 7:00AM-4:30PM (Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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BKS/3691